

REMARKS

Claims 1-13, 15-28, 30-43 and 45 are now pending in the present application. Claims 1, 9, 11, 16, 26, 31 and 41 have been amended, and Claims 14, 29 and 44 have been cancelled, herewith. Reconsideration of the pending claims is respectfully requested.

I. 35 U.S.C. § 102, Anticipation

The Examiner rejected Claims 1, 9, 14, 16, 29, 31, 39 and 44 under 35 U.S.C. § 102(b) as being anticipated by Nielsen (US Pat No. 5,899,975, 5/4/99, filed 4/3/97). This rejection is respectfully traversed.

Claim 1 has been amended to include features previously recited in Claim 14 (which is thus being cancelled herewith without prejudice or disclaimer). As to amended Claim 1, such claim now recites that the identifying step includes identifying the plurality of subset style sheets based on characteristics of a client device to which the electronic document is to be sent. As can be seen, the plurality of subset style sheets are identified *based on characteristics of a client device to which the electronic document is to be sent*, in addition to the contents of the electronic document itself, which advantageously allows for using a set of style sheets when transforming a document such that the document can be properly presented on the client device (Specification page 14, lines 21-27). In rejecting Claim 14, whose features are now included in amended Claim 1, the Examiner states that the features of Claim 14 are taught by Nielsen at Figure 7 and Col. 5, lines 52-67. Applicants urge that Nielsen states at Col. 5, lines 52-67:

"FIG. 4 is an illustration of an exemplary stylesheet data base. A stylesheet data base 240, shown in FIG. 2 can be implemented, in one example, as shown in FIG. 4. FIG. 4 shows three columns. Each record in the data base has an entry for each of the columns. When a document refers to a particular stylesheet, the document identifier is listed in column 1. The stylesheet address or addresses of one or more stylesheets associated with that document are listed in column 2. The type of address listed in column 2 is identified in column 3 in this example. If the document in question is local, the document identifier shown in FIG. 1 may be a filename on the local computer. Otherwise, it may be a network address where the document can be retrieved. Stylesheets may also be local or remote. If they are

local, then they are identified by a particular device and address range within the device between which the information is stored."

As can be seen, this passage describes entries of a stylesheet database, and each entry includes three fields. The first field is a document identifier for a particular stylesheet, and this document identifier does not identify or otherwise provide any information with respect to a client device to which the electronic document is to be sent. The second field is an address of where to locate the document, and this address field does not identify or otherwise provide any information with respect to a client device to which the electronic document is to be sent. The third field identifies whether the address specified in field 2 is local or remote, to assist in *retrieval of the document*. This field does not identify or otherwise provide any information with respect to *a client device to which the electronic document is to be sent*. It is therefore urged that, and contrary to the Examiner's assertion with respect to Claim 14, this cited passage does not teach the claimed feature of "wherein identifying a plurality of subset style sheets further includes identifying the plurality of subset style sheets based on characteristics of a client device to which the electronic document is to be sent". Since Claim 1 has been amended herewith to include this feature previously recited in Claim 14, and since the feature of Claim 14 is not taught by the cited reference, it is urged that the amendment to Claim 1 has overcome the present 35 USC 102 rejection.

With respect to Claim 9, such claim has been amended to further emphasize the nature of the composite style sheet and its use when present for use. If the composite style sheet is not present, then the subset style sheets are used instead. The cited reference unconditionally combines style sheets irrespective of whether a composite style sheet is present (Figure 7, block 730). It is thus urged that the amendment to Claim 9 has overcome the present 35 USC 102 rejection.

Claims 16 and 31 have been amended in similar fashion to Claim 1 (and Claims 29 and 44 have thus been cancelled herewith without prejudice or disclaimer), and Applicants traverse the rejection of amended Claims 16 and 31 for similar reasons to those given above with respect to Claim 1.

Applicants traverse the rejection of Claim 39 for reasons given above with respect to Claim 31 (of which Claim 39 depends upon).

Therefore, the rejection of Claims 1, 9, 14, 16, 29, 31, 39 and 44 under 35 U.S.C. § 102(b) has been overcome.

II. 35 U.S.C. § 103. Obviousness

A. The Examiner rejected Claims 2-7, 15, 17-23, 30, 32-37 and 45 under 35 U.S.C. § 103 as being unpatentable over Nielsen as applied to Claims 1, 16 and 31 above and further in view of Walsh, *The Extensible Style Language: [XSL] Styling XML Documents*, Web Techniques, Jan 1999, vol. 4, iss. 1, pg. 49, 5 pgs, printed from ProQuest as pages 1-10).

This rejection is initially traversed for similar reasons to those given above with respect to independent Claims 1, 16 and 31.

Further with respect to Claim 23, it is urged that none of the cited references teach or suggest the claimed feature of "a composite style sheet repository for storing the composite style sheet" (that was generated pursuant to Claim 16), nor has the Examiner alleged any such teaching/suggestion. It is thus further urged that Claim 23 has been erroneously rejected, as a proper prima facie showing of obviousness has not been established with respect to such claim¹, and accordingly the burden has not shifted to Applicants to rebut such obviousness assertion².

Therefore, the rejection of Claims 2-7, 15, 17-23, 30, 32-37 and 45 under 35 U.S.C. § 103 has been overcome.

B. The Examiner rejected Claims 8, 24 and 38 under 35 U.S.C. § 103 as being unpatentable over Nielsen (US Pat No. 5,899,975, 5/4/99, filed 4/3/97).

This rejection is initially traversed for similar reasons to those given above with respect to independent Claims 1, 16 and 31.

Further with respect to Claim 24, Applicants traverse for similar reasons to those given above with respect to Claim 23 (of which Claim 24 depends upon).

¹ To establish prima facie obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. MPEP 2143.03. See also, *In re Royka*, 490 F.2d 580 (C.C.P.A. 1974). If the examiner fails to establish a prima facie case, the rejection is improper and will be overturned. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

² In rejecting claims under 35 U.S.C. Section 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Only if that

Still further with respect to Claim 24, it is urged that none of the cited references teach or suggest the claimed feature of "wherein the transcoder determines if a composite style sheet for the electronic document is present in the composite style sheet repository and, if a composite style sheet for the electronic document is present in the composite style sheet repository, the transcoder makes use of the composite style sheet in the composite style sheet repository", nor has the Examiner alleged any such teaching/suggestion. It is thus further urged that Claim 24 has been erroneously rejected, as a proper prima facie showing of obviousness has not been established with respect to such claim, and accordingly the burden has not shifted to Applicants to rebut such obviousness assertion.

Therefore, the rejection of Claims 8, 24 and 38 under 35 U.S.C. § 103 has been overcome.

C. The Examiner rejected Claims 10, 25 and 40 under 35 U.S.C. § 103 as being unpatentable over Nielsen in view of Walsh as applied to claim 2 above, and further in view of Feibus, Visual InterDev Improves, InformationWeek, September 28, 1998, Iss. 702, pg. 18A, 2 pgs, printed from ProQuest as pages 1-3. This rejection is respectfully traversed for similar reasons to those given above with respect to independent Claims 1, 16 and 31.

Therefore, the rejection of Claims 10, 25 and 40 under 35 U.S.C. § 103 has been overcome.

D. The Examiner rejected Claims 11-13, 26-28 and 41-43 under 35 U.S.C. § 103 as being unpatentable over Nielsen as applied to claim 1 above, and further in view of Boag et al. (US Pat No. 6,589,291 B1, 7/8/03, filed 4/8/99). This rejection is respectfully traversed.

With respect to Claims 11-13, 26-28 and 41-43, Applicants urge that the cited Boag reference should be excluded for the following reason:

The present application and the cited Boag reference were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same corporation – International Business Machines Corporation.

burden is met, does the burden of coming forward with evidence or argument shift to the applicant. *Id.*

Page 13 of 14
Fiedorowicz et al. – 09/595,288

Thus, the cited Boag reference is disqualified as being prior art pursuant to 35 USC 103(c).

Therefore, the rejection of Claims 11-13, 26-28 and 41-43 under 35 U.S.C. § 103 has been overcome.

III. Conclusion

It is respectfully urged that the subject application is patentable over the cited references and is now in condition for allowance. The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

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Respectfully submitted,



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